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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
CAPRON, AARON J	
ART UNIT	**PAPER NUMBER**
3714	10

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/027,888	MCCLINTIC, MONICA A.	
	Examiner	Art Unit	
	Aaron J. Capron	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 November 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,8,10-36 and 43-52* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,8,10-36,43-49,51 and 52* is/are rejected.

7)☒ Claim(s) *50* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

This is a response to the Amendment received on November 21, 2003, in which claims 8, 12 and 22 were amended, claims 43-52 were added, and claims 5-7, 9 and 37-42 were cancelled. Claims 1-4, 8, 10-36 and 43-52 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 8, 10-36, 43-49 and 51-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher et al. (U.S. Patent No. 6,406,369; hereafter "Baerlocher").

Referring to claims 1-2, Baerlocher discloses a method comprising providing, in association with a primary game, a bonus game comprising a simulated contest against an opponent (Figure 1); providing the player an opportunity to play one of the primary game or the bonus game (Figure 1, abstract); in association with play of the bonus game to represent the player in the simulated contest against the opponent (Figure 4); and randomly determining an outcome of at least one of the primary game and the bonus game. Baerlocher discloses that any game can be used as the bonus game selection (6:49-53, 9:54-57) that would encompass fighting games, but Baerlocher lacks a player selectable characters. However, it is notoriously well known in fighting games that players can select a game character that the player will use to compete against opposing game characters in order to give the player the best chance of winning

the game. The additional game characters add variety to the game so players have the opportunity to use different game characters and therefore be interested in the game longer and in addition, use characters that they are comfortable with to give the players the best chance for winning. One would be motivated to combine the features in order to allow a player the opportunity to select a game character in order to allow the player the best opportunity to win the game. It is also well known within the art of gaming that a team of players (2 players vs 2 players) can select which sports team in order to play their favorite teams or players. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the ability to select a game character into Baerlocher's game in order to allow the player the best opportunity to win the game.

Referring to claim 3, Baerlocher discloses that any game can be used for the bonus game. It is notoriously well known in games that players have the opportunity to use items or game character elements in order to help the character proceed further in the game. One would be motivated to combine the references in order to allow game characters to proceed further into the game. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate game elements into the bonus game of Baerlocher in order to help the player proceed farther into the game and help the player win more money.

Referring to claim 4, as shown above, Baerlocher discloses using a plurality of characters that have been used in previous games. It is inherent that the game characters were created by the gaming programmers or designers, thus previously created.

Referring to claim 8, Baerlocher discloses the bonus trigger events include at least some of a randomly timed bonus triggered event trigger, a specified outcome form play of the primary

game, a challenge from another player already participating in the bonus game, and use of a predetermined number of credits to buy play in the bonus game (10:37-43).

Referring to claim 10, Baerlocher discloses that a plurality of players can play the bonus game to have teams play against each other (6:55-59).

Referring to claims 11-13, Baerlocher discloses that any contest, competition, event or situation can used for the bonus game (9:54-57) and that the competition is displayed (Figure 1). The game can go as long as the player continues winning or wins the contest.

Referring to claim 14, Baerlocher discloses structuring the bonus game characters and the simulation of combat from a selection of modular components. It is inherent for a software game program to have modular components.

Claims 15-28 correspond in scope to a method of conducting a game set forth for use of the method listed in the claims above and are encompassed by use as set forth in the rejection above. Sports games have an offensive and defensive side of the ball and combat games have offensive and defensive movements within the game.

Claims 29, 33, 35-36 correspond in scope to a method of conducting a game set forth for use of the method listed in the claims above and are encompassed by use as set forth in the rejection above.

Referring to claim 30, Baerlocher discloses at least one competition includes a plurality of competitions (6:47-59).

Referring to claims 31-32 and 34, Baerlocher discloses an award value with each competition of the plurality of competitions (7:45-50).

Claims 43-45, 49 and 51-52 correspond in scope to a gaming system set forth for use of the gaming method listed in the claims above and are encompassed by use as set forth in the rejection above.

Referring to claims 46-47, Baerlocher insinuates a plurality of gaming machines set up in a network (6:5-19) where a plurality of players can play a game. Baerlocher states that a player can reach a bonus competition once the player's gaming triggers the bonus game (abstract). Further, Baerlocher states that a plurality of participants can play in the competition in the bonus game (6:55-59).

Referring to claim 48, Baerlocher discloses a bonus round wherein the further a player advances within the bonus game, the more money the player will receive, but does not specifically disclose having a progressive jackpot. However, it is notoriously well known within the art of gaming machines to include a progressive jackpot within a gaming competition in order to attract players who prefer to play for larger outcomes. One would be motivated to provide a progressive jackpot to Baerlocher in order to attract players who prefer to play for larger outcomes. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a progressive jackpot into the gaming device of Baerlocher in order to attract players who prefer to play for larger outcomes.

Allowable Subject Matter

Claim 50 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

While the prior art reference of record provides a gaming machine having a triggering event that initiates a bonus game competition. However, the prior art fails to teach, disclose or suggest wherein the bonus triggering event is a challenge from another player participating in the bonus game, as claimed in Applicants' invention.

Response to Arguments

Applicant's arguments filed November 21, 2003 have been fully considered but they are not persuasive.

Applicant argues that the obviousness rejection of Baerlocher lacks a player selectable character. Applicant further sites In re Lee, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), which states that "deficiencies of the cited references cannot be remedied...by general conclusions about what is 'basic knowledge' or 'common sense'." Accordingly, the Federal Circuit particularly found fault with the suggestion that there is not need for a "specific hint or suggestion in a particular reference" to support a combination of references. In particular, the Federal Court required that ordinarily, there must be some sort of evidence in the record to support an assertion of common knowledge (MPEP 2144.03). However, as stated above, Baerlocher discloses that any game can be used as the bonus game selection (6:49-53, 9:54-57) which would encompass fighting games, but Baerlocher lacks a player selectable characters. As stated above, it is notoriously well known in video games that players can select a game character in order to use the game character throughout the competition. The Examiner sited Logg (U.S. Patent No. 4,738,451) in the previous action (Paper #7, page 6, under Conclusion) supporting that players can select their own game characters (Logg Figure 3, item 31). Logg was

previously disclosed on the record showing the well-known feature, thus, the rejection is deemed proper. Therefore, the claimed invention fails to preclude the obviousness rejection of Baerlocher.

Applicant argues that Baerlocher fails to disclose providing a plurality of gaming machines and at least one display for exhibiting a competition between two different characters being associated with a gaming machine of the plurality of gaming machines. However, Baerlocher discloses that a player playing a gaming machine can reach a competition when entering the bonus round (abstract) and states that a plurality of players can participate in a particular bonus competition (6:55-59). Therefore the claimed invention fails to preclude the obviousness rejection of Baerlocher.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nakatani et al. (USPN 5,720,663) discloses a player selecting game characters in a fighting game (Figure 6 and 7).

Guinn et al. (USPN 6,039,648) discloses a slot tournament having progressive outcomes.

NBA Jam Extreme discloses a 2 player vs 2 player video basketball game.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-Th 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

ajc

MARK SAGER
PRIMARY EXAMINER